

Remarks

I. Introduction

This is in response to the Office Action dated August 1, 2006.

The Office Action rejected claims 1-13 under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

The Office Action rejected claims 1-13 and 15-17 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-6 and 13-15 of U.S. Patent No. 6,775,267.

The Office Action rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,187,710 to Chau et al. (Chau) in view of “Index: A Platform for Determining how People Value the Quality of their Internet Access” by Rupp et al. (Rupp).

Claims 1, 3, and 9 have been amended.

Claims 1-17 are pending in this application.

This application is a continuation of prior Application No. 09/475,797 filed December 30, 1999 (hereinafter “parent application”). Applicants request consideration of the currently pending claims in view of all the art of record in both the parent application (see MPEP §2001.06(b)) and the present application.

II. Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 1-13 under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential steps. In particular, the Examiner rejects claim 1, because “the claim has no post solution of ‘billing’ a user after the termination of the connection.” The Examiner seems to suggest that because claim 1 is directed to a method of billing, there must be a step in that claim in which billing is performed. In order to expedite prosecution, Applicants’ have amended the preamble claim 1 to recite “A method of providing to a subscriber a least cost for a variable bit rate communication between a first

terminal and a distant terminal to said subscriber." Thus, the step of billing is not essential for this claim to be complete. Furthermore, the step of coupling the terminals is not essential, since the cost for a communication can be provided to a subscriber before the communication is initiated.

MPEP § 2172.01 states that a claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. The Examiner claims that the steps of "coupling the terminals together via said least cost alternative network resources for communication according to said default quality of service; and billing the call after the termination of the connection" are essential. However, nowhere in the specification are these steps disclosed as being essential. In fact, as disclosed at pages 57-60 of the specification, in response to the least cost for a communication at a default quality of service and a required bit rate, a subscriber may choose not to connect using that communication (and thus not be billed), and select a communication having a different quality of service or required bit rate. Accordingly, the steps of coupling the terminals and billing after the communication are not essential to the invention of providing a least cost for a communication.

Thus, for the reasons discussed above claims 1-13 are allowable under 35. U.S.C. § 112.

III. Double Patenting Rejection

In order to expedite prosecution, Applicants are hereby filing a terminal disclaimer under 37 C.F.R. §1.321(c). Withdrawal of the double patenting rejection is respectfully requested.

IV. Rejection under 35 U.S.C. §103(a)

Independent claim 14 was rejected as being unpatentable over Chau in view of Rupp. In order to "establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the

prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. Neither of the cited references, either alone or in combination, teach all of the claim limitations of independent claim 14. Therefore, Applicants request the withdrawal of the rejection under 35 U.S.C. §103(a).

The present invention is generally directed to a method for billing broadband subscribers. This method bills a subscriber for a variable bit rate communication between the subscriber's terminal and a remote terminal. As described at pages 57-60 of the specification, billing parameters are changed in real time during the communication in response to user inputs requesting changes in a quality of service level (see FIG. 7(a)), bit rate (see FIG. 7(b)), and preferred service provider (see FIG. 7(c)). As shown in FIG. 7(c) and described at page 58 line 21 – page 59 line 12, a subscriber can select a preferred service provider (i.e., AT&T, MCI, Sprint, etc.) or change the preferred service provider in real time during a communication. The billing parameters change in response to the change in preferred service provider in real time.

This aspect of the present invention is recited in independent claim 14. More particularly, claim 14 recites “A method comprising billing a variable bit rate communication between a first terminal and a distant terminal to a broadband subscriber, said billing comprising changing billing parameters during the communication in real time in response to user inputs including user-requested changes in preferred service provider.”

Chau is directed to a method of billing communication calls. As described therein, an ISDN connection is established between a network and a called location. This enables the called location to specify billing information to the network on a call by call basis. The method described in Chau allows the called party to have real time access to network rate tables to specify call billing parameters needed to generate a separate billing record for each call made to the called location. Although Chau discloses billing parameters changing in real

time, the billing parameters vary depending on call type, time of day, and geographic region. Chau does not disclose the billing parameters changing in response to real time changes in preferred service provider. Thus, Chau fails to disclose “changing billing parameters during the communication in real time in response to user inputs including user-requested changes in preferred service provider,” as recited in independent claim 14.

Rupp is directed to a platform designed to obtain a basic understanding of how individuals value Internet usage when offered different quality of service choices. At section 2.2, lines 1-11, Rupp describes a java application which enables a user to select different qualities of service and control their usage of network resources. This application allows users to change their quality of service during active sessions. The Examiner states that this application enables users to select different prices, but this is inaccurate. As described at section 2.2 lines 7-9, the application consists of a small window informing the user of the price schedule currently in effect. Accordingly, the user can select different quality of services and see the resulting changes in price, but cannot independently control the price. The application disclosed in Rupp does not enable the user to select or change service providers during an active session.

The Examiner asserts that the price inherently corresponds to the service provider. The Examiner seems to be reasoning that since Rupp discloses a user changing the prices in real time, this inherently shows that a user can change service providers in real time. This reasoning is flawed. The Examiner cites “INDEX Project: User Support for Buying QoS with Regard to User’s Preferences” by Altmann et al. (Altmann) to support the assertion that price inherently corresponds to the service provider. Although Altmann does describe two Internet service providers offering the same services at different prices, prices may change for other reasons without changing service providers. Thus a change in price does not inherently correspond to a change in service provider. Altmann does not disclose changing service providers in real time during a communication. Furthermore, as described above, the real-time changes in prices shown in Rupp are a result of the changes in quality of service, not

changes in service provider. Therefore, Rupp fails to disclose "changing billing parameters during the communication in real time in response to user inputs including user-requested changes in preferred service provider," as recited in independent claim 14.

Thus, for the reasons discussed above, independent claim 14 is allowable over the cited art.

V. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,



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